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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/849,402

05/19/2004

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10500.04.0427

6974

23418 7590 08/01/2008  
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EXAMINER

CHEN, SHIN HON

ART UNIT

PAPER NUMBER

2131

MAIL DATE

DELIVERY MODE

08/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/849,402	<b>Applicant(s)</b> VOICE ET AL.	
	<b>Examiner</b> SHIN-HON CHEN	<b>Art Unit</b> 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 29-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/27/05; 12/07/05 and 3/16/07</u> .                           | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-35 have been examined.

#### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: The claim recites desired sender authentication information that corresponds to sender authentication information and sender identification information can be located on the article by using location information. However, according to the specification, sender authentication information is located using the location information. Therefore, the terms "sender identification information" and "sender authentication information" appear to refer to the same information yet they are phrased differently. Appropriate action to clarify claimed invention is required.
3. Claim 14 is objected to because of the following informalities: claim 14 recites "the expected sender authentication information on the article" instead of "the sender authentication information on the article" when there was no prior recitation of "expected sender authentication information". Appropriate correction is required.
4. Claim 15 is objected to because of the following informalities: claim 15 recites "the location" in line 4 when there is no prior recitation of "a location". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 14 and 24 recite the limitation "the sent sender authentication information" in line 5 and 4 respectively. There is insufficient antecedent basis for this limitation in the claim because claim 1 discloses sender authentication information and desired sender authentication information which both were sent to the recipient.

***Allowable Subject Matter***

8. Claims 27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-8, 10-13, 15-26 and 29-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Watts U.S. Pat. No. 5712627 (hereinafter Watts).

11. As per claim 1, Watts discloses a method for providing electronic message authentication comprising: determining, for a recipient that has been assigned an article, desired sender authentication information that corresponds to sender authentication information that is embodied on the article that has been assigned to the recipient (Watts: column 2 lines 7-15: access to secured system is partially granted if the sender authentication information/identification card is authenticated by matching the randomly generated addressable indicium), and which sender identification information can be located on the article by using location information (Watts: figure 1: the identification card comprises rows and columns as location information to assist user enter corresponding indicium to access resource); and sending an electronic message and both the location information and the desired sender authentication information for the recipient (Watt: column 2 lines 37-64: the security system prompts user to enter information/electronic message and also provides sender authentication and information in the form of identification card to users).

12. As per claim 2, Watts discloses the method of claim 1. Watts further discloses wherein the location information and the sender authentication information includes electronically transmitted data for display on a display device (Watts: column 3 lines 27-33: the location information/randomly specified addressable position is electronically transmitted and displayed to prompt user to enter sender authentication information/printed indicia).

13. As per claim 3, Watts discloses the method of claim 1. Watts further discloses wherein the article issued to the recipient contains sender authentication information that is arranged in rows and columns (Watts: figure 1: the indicia are addressable through rows and columns).

14. As per claim 4, Watts discloses the method of claim 1. Watts further discloses wherein the article issued to the recipient is a transaction card (Watts: column 2 lines 37-41: the transaction card/identification security card allows access to resources).

15. As per claim 5, Watts discloses the method of claim 4. Watts further discloses wherein the sender identification information and location information is affixed to the article (Watts: figure 1: the indicia/sender authentication information and location information/columns and rows are printed on the card).

16. As per claim 6, Watts discloses the method of claim 4. Watts further discloses wherein the sender identification information and location information are on a member that may be attached to the article (Watts: figure 1).

17. As per claim 7, Watts discloses the method of claim 1. Watts further discloses wherein the sent location information and desired sender identification information is in the form of a visual filtering pattern and wherein the visual filtering pattern directs the recipient to a location on the article containing the sender authentication information (Watts: column 3 lines 27-33 and

figure 1: the matrix printed on the identification card is in the form of a visual filtering pattern that requires the user to visually filter for information indicated by the location information).

18. As per claim 8, Watts discloses the method of claim 1. Watts further discloses wherein the sent sender identification information is a pointer that directs the recipient to the sender authentication information (Watts: column 3 lines 29-32: randomly generated addressable position).

19. As per claim 10, Watts discloses the method of claim 1. Watts further discloses wherein the article is an electronic representation of an article (Watts: column 2 lines 37-40: the article can be hardware or software/data).

20. As per claim 11, Watts discloses the method of claim 10. Watts further discloses wherein the electronic representation of the article can be displayed so as to be read by a recipient (Watts: column 2 lines 37-41).

21. As per claim 12, Watts discloses the method of claim 10. Watts further discloses wherein the electronic representation of the article can be accessed by a software application so as to provide the recipient with the sender authentication information located at the location identified by the sent location information (Watts: column 3 lines 28-32).

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22. As per claim 13, Watts discloses the method of claim 1. Watts further discloses the steps of issuing an article to a recipient wherein the article contains at least: (a) sender authentication information that is identifiable by location information (Watts: figure 1: indicia); (b) location information (Watts: figure 1: column and rows indicators); and (c) an article identifier linked to the recipient (Watts: column 1 lines 16-17: cards typically contain card identification number).

23. As per claim 15-23, 25-26, 29-33 and 35, claims 15-23, 24-26, 29-33 and 35 encompass the same scope as claims 1-8 and 10-13 by disclosing authenticating sender authentication information by comparing sender authentication information/indicia stored by the system that correspond to the indicia printed on identification card to verify whether access can be granted.

24. Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Goede U.S. Pat. No. 5246375 (hereinafter Goede).

25. As per claim 35, Goede discloses a transaction card comprising: transaction card identification information (Goede: column 3 lines 25-29); sender authentication information identifiable by location information (Goede: column 2 lines 62 - column 3 line 10 and figure 1: the random digit represented in a matrix); a translucent identification member (Goede: column 2 lines 45-47: the substrate may be transparent, frosted, colored or opaque); and location information (Goede: column 2 lines 56-61: the location designating symbols).



***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 9 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watts.

28. As per claims 9 and 34, Watts discloses the method of determining whether indicia stored by the sender system/card providing side matches the indicia printed on identification card (Watts: column 3 lines 27-33). Watts does not explicitly disclose a pointer that takes the recipient to a web page containing the sender authentication information. However, Watts discloses the secured system could be applied to any communication system and it would have been obvious to one having ordinary skill in the art to incorporate the secured system to web communication as to allow the comparison of indicia to take place following redirection of server to authentication web page.

***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Oksman et al. U.S. Pat. No. 5233436 discloses optical filter software copy protection.

Kohut U.S. Pat. No. 6246769 discloses authorized user verification by sequential pattern recognition and access code acquisition.

McVoy et al. U.S. Pat. No. 3827726 discloses identification cards that contains a validation pattern to be superimposed.

Shiang et al. U.S. Pat. No. 4921278 discloses identification system using computer generated moire.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIN-HON CHEN whose telephone number is (571)272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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